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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/148,533	09/04/1998	LELAND LESTER	98P7649US	3513

7590

03/23/2005

SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
186 WOOD AVENUE SOUTH
ISELIN, NJ 08830

EXAMINER

HAROLD, JEFFEREY F

ART UNIT	PAPER NUMBER
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2644

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/148,533	Applicant(s) LESTER ET AL.	
	Examiner Jefferey F Harold	Art Unit 2644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 17-24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 17-24 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1, 4, 7, 10, 19 and 22** are rejected under 35 U.S.C. 102(b) as being anticipated by Pavitt, Jr. (United States Patent 4,517,413), hereinafter referenced as Pavitt.

Regarding **claim 1**, Pavitt discloses a telephone triggered switching system for transceiver. In addition, Pavitt discloses an apparatus (control box) for connecting a microphone alternately to a telephone line and an alternate device (transcriber), the apparatus comprising: a device connector for connecting the apparatus to the alternate device; a telephone connector for connecting the apparatus to the telephone line; a microphone connector for connecting the apparatus to the microphone; and a switching circuit connected to the device, telephone and microphone connectors, the switching circuit connecting the telephone connector to the microphone connector in response to sensing a ringing signal, which reads on claimed "sensing a voltage greater than a predetermined threshold", on the telephone line, and the switching circuit switching back

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to the previous state, which reads on claimed "connecting the microphone connector to the alternate device connector when the voltage on the telephone line is less than the predetermined threshold voltage", (i.e. the call is complete, thus returning the circuit to the on-hook voltage), as disclosed at column 3, lines 5-37 and exhibited in the figure.

Regarding **claims 4, 7, 10, 19 and 22**, they are interpreted and thus rejected for the reasons set forth above in the rejection of claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. ***Claims 2, 3, 5, 6, 8, 9, 11, 17, 18, 20, 21, 23, 24 and 26*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavitt in view of well know prior art (MPEP 2144.03).

Regarding **claim 2**, Pavitt disclose everything claimed, as applied above, (see claim 1), in addition Pavitt discloses wherein the switching circuit is included in a module, however, Pavitt fails to disclose a computer telephone integration module. Pavitt does disclose a telephone and the transcription device which is a computer. Thus the module functions as a computer telephone integration module. Hence, the examiner takes official notice of the fact that it was well know in the art to provide a computer telephone integration module.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pravitt by specifically providing a computer telephone integration module, for the purpose of answering the telephone with out having to remove a headset to pick up the receiver to answer the call.

Regarding **claim 3**, Pavitt disclose everything claimed, as applied above, (see claim 1), in addition Pavitt discloses a Sony micro dictation/transcriber, however, Pavitt fails to disclose a personal computer. However, the examiner takes official notice of the fact that it was well know in the art to provide a personal computer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pravitt by specifically providing a personal computer, for the purpose of electronically entering of data.

Regarding **claim 17**, Pravitt discloses an apparatus for switching between a personal computer and a telephone, comprising: a device connector for connecting the apparatus to the personal computer, a telephone connector for connecting the apparatus to the telephone line; a microphone connector for connecting the apparatus to the microphone; a switching circuit connecting the device, telephone and microphone connectors, the switching circuit connecting the telephone connector to the microphone connector in response ringing voltage and the switching circuit connecting the microphone connector to the device connector in response to completion of call, however, Pavitt fails to disclose switching in response to a first and second voice command. However, the examiner takes official notice of the fact that it was well know in the art to provide switching in response to a first and second voice command.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pravitt by specifically providing switching in response to a first and second voice command, for the purpose of alternating between two known states.

Regarding **claims 5, 6, 8, 9, 11, 18, 20, 21, 23, and 24**, they are interpreted and thus rejected for the reasons set forth above in the rejection of claims 2 and 3.

Regarding **claim 26**, it is interpreted and thus rejected for the reasons set forth above in the rejection of claim 17.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. ***Claims 1-11 and 19-24*** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,091,812. Although the conflicting claims are not identical, they are not patentably

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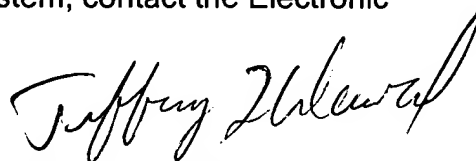
distinct from each other because they both directed to alternately switching between a telephone and a second device based on sensed voltage.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jefferey F Harold whose telephone number is 703-306-5836. The examiner can normally be reached on Monday - Friday 9 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh H Tran can be reached on 703-305-4040. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jefferey F Harold
Examiner
Art Unit 2644



JFH
March 10, 2005